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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,878	11/17/2003	Bruce A. Phillips	020366-090000US	5290
20350	7590	09/25/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SWERDLOW, DANIEL	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,878

Applicant(s)

PHILLIPS ET AL.

Examiner

Daniel Swerdlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-41 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 and 43-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 through 41 and 43 through 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Regarding Claim 1, the original specification fails to disclose an embodiment that converts one of a set of combined signals on an interface into two separate signals, each comprising digitally formatted video information in a distinct digital video format, and combines one of the separate signals with additional signal from a different interface and maps the combined signal and the signal comprising the digitally formatted video information in the digital video format that was not combined with the additional signal onto separate interfaces for distribution.

4. Claims 2 through 14 and 43 through 45 incorporate the new matter of Claim 1 by dependence therefrom.

5. Claim 15 contains limitations similar to those of Claim 1 and, as such, incorporates the same new matter.

6. Claims 16 through 28 incorporate the new matter of Claim 15 by dependence therefrom.

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7. Claim 29 contains limitations similar to those of Claim 1 and, as such, incorporates the same new matter.

8. Claims 30 through 41 incorporate the new matter of Claim 15 by dependence therefrom.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1 through 41 and 43 through 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabenko et al. (WO 01/19005 A1) in view of Okawa et al. (US 2002/0129154 A1) and further in view of Bowen et al. (US Patent 6,580,710).

11. International application WO 01/19005 A1 is prior art to the instant application under 35 USC 102(b) based on its publication date of 15 March 2001. For convenience, in the rejections below examiner makes reference to column and line numbers in US Patent 6,819,682, the disclosure of which is identical. The only exception is the rejection of Claim 11, which is based on Fig. 1 of Appendix A of the published international application. While the appendices in the published international application are in the prosecution record of the application for US Patent 6,819,682, they are not included in that patent publication.

12. Regarding Claim 1, Rabenko discloses a cable modem (Fig. 2, reference 2600; Fig. 3, reference 2300; column 4, lines 46-55) that corresponds to the network interface device claimed and comprises: an interface to an HFC network (Fig. 2, reference 1010; Fig. 3, reference 2060; column 3, lines 18-20) that corresponds to the external interface claimed and receives internet, television and telephone (i.e., a plurality of telecommunication services) (column 2, line 64-

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column 3, line 21) using Data Over Cable Service Interface Specifications (column 3, lines 47-52); interfaces to an HPNA network, a computer, a telephone and a television receiver (Fig. 2, reference 2015, 2012, 2014; column 3, lines 32-46) that correspond to the at least two distinct internal interfaces claimed and are connected to twisted pair wires, USB cable, telephone cord and coaxial cable that correspond to the internal transport media claimed; and a DOCSIS CPE controller (Fig. 3, reference 2313; column 6, lines 65-66) that corresponds to the processor claimed and receives combined signals from the HFC network interface that corresponds to the external interface claimed and separates and maps those signals to one of the interfaces to an HPNA network, a computer, a telephone and a television receiver that correspond to the internal interfaces claimed (column 3, lines 21-46), with the signals to the television receiver corresponding to the signals in the second digital video format claimed. Therefore, Rabenko anticipates all elements of Claim 1 except converting one of the combined signals into separate signals with a first and second digital video format, respectively, and a second external interface that receives an additional telecommunication service, the signal comprising which is combined with the signal created by converting one of the separate signals to a first digital video format to create a combined signal that is mapped to an internal interface.

13. Okawa discloses an audio/video router (Fig. 3, reference 101) that converts video signals to an MPEG digital format that corresponds to the first digital video format claimed for transmission to PC's on a home local area network (0026-0029). Okawa further discloses that such an arrangement permits viewing of video content on PC's without the expense of a special network and special interfaces (0004-0006). It would have been obvious to one skilled in the art at the time of the invention to apply video format conversion as taught by Bowen to the cable

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modem taught by Rabenko for the purpose of realizing the aforesaid advantage. Bowen discloses a broadband communication interface (Fig. 3, reference 301; column 3, lines 41-49) that, in addition to a coaxial cable interface 304, has a twisted pair interface 303 that corresponds to the second external interface claimed and combines telephone signals that correspond to the additional telecommunication service claimed with data signals that correspond to one of the separate signals claimed to form an HPNA signal that corresponds to the combined signal claimed and is mapped to a phone line distribution interface that corresponds to the internal interface claimed (column 3, lines 50-62). Bowen further discloses that such an arrangement provides broadband services to customer premises without the expense and inconvenience of installing new network wiring (column 2, lines 24-34). It would have been obvious to one skilled in the art at the time of the invention to apply mapping of a combination of telephone services from one external interface and data services from another external interface onto an internal interface as taught by Bowen to the combination made obvious by Rabenko and Okawa for the purpose of realizing the aforesaid advantage.

14. Regarding Claim 2, Rabenko further discloses provision of 2-way services such as internet access and telephony via the DOCSIS CPE controller (column 3, lines 40-46).

15. Regarding Claim 3, Rabenko further discloses the interfaces to an HPNA network, a computer and a telephone (Fig. 2, reference 2015, 2012, 2014; column 3, lines 32-46) that correspond to the at least two distinct internal interfaces claimed receive internet and telephone signals (i.e., signals relating to telecommunication services) (column 2, line 64-column 3, line 21) from their respective media.

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16. Regarding Claim 4, Rabenko further discloses provision of 2-way services such as internet access and telephony via the DOCSIS CPE controller (column 3, lines 40-46). As such, Rabenko discloses receiving separate signals from the respective media, and combining them onto the HFC network interface (Fig. 2, reference 1010; Fig. 3, reference 2060; column 3, lines 18-20) that corresponds to the external interface claimed using Data Over Cable Service Interface Specifications (column 3, lines 47-52).

17. Regarding Claim 5, Rabenko further discloses the DOCSIS CPE controller (Fig. 3, reference 2313) integrates signals from the telephone (Fig. 3, reference 2001) and the HPNA controller (Fig. 3, reference 2311) onto the HFC network interface (Fig. 2, reference 1010; Fig. 3, reference 2060; column 3, lines 18-20) that corresponds to the external interface claimed (i.e., into a combined information set).

18. Regarding Claim 6, Rabenko further discloses an internal interface to a TV set (i.e., coaxial cable) (Fig. 2, reference 2014; column 3, lines 44-46).

19. Regarding Claim 7, Rabenko further discloses an internal interface to an HPNA network (i.e., twisted pair cable) (Fig. 2, reference 2015; column 3, lines 32-34).

20. Regarding Claim 8, Rabenko further discloses an internal interface to an HPNA network (i.e., the twisted pair cable comprises existing telephone wiring) (Fig. 2, reference 2015; column 3, lines 32-34).

21. Regarding Claim 9, Rabenko further discloses use of Ethernet in place of the HPNA network (column 5, lines 46-51).

22. Regarding Claim 10, Rabenko further discloses provision of television, internet and telephone (i.e., video, data and voice) (column 2, line 64-column 3, line 21).

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23. Regarding Claim 11, Rabenko further discloses provision of different services via different frequency ranges (Appendix A, Fig. 1).

24. Regarding Claim 12, Rabenko further discloses use of Ethernet and IEEE 802.11 (column 5, lines 46-54).

25. Regarding Claim 13, Rabenko further discloses an internal interface to an HPNA network (Fig. 2, reference 2015; column 3, lines 32-34).

26. Regarding Claim 14, Rabenko further discloses provision of service from a cable television network and a public telephone network (column 1, lines 57-64). It is not a patentable limitation on the interface device that the additional service is provided by a different business entity.

27. Claims 15 through 28 are essentially similar to Claims 1 through 14 and are rejected on the same grounds.

28. Claims 29 through 41 are essentially similar to Claims 1 through 13 and are rejected on the same grounds.

29. Regarding Claim 43, Bowen further discloses the interface that corresponds to the second external interface claimed is a twisted pair interface 303.

30. Regarding Claim 44, Bowen further discloses the telephone signal that corresponds to the additional signal claimed is a POTS (i.e., analog) signal (column 4, lines 18-20) and the data signal that corresponds to the separate signal claimed is a data-LAN (i.e., digital) signal (column 4, lines 26-31).

31. Regarding Claim 45, Bowen further discloses the telephone signal that corresponds to the additional signal claimed is an Ethernet (i.e., digital) signal (column 4, lines 54-56), the data

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signal that corresponds to the separate signal claimed is a data-LAN (i.e., digital) signal (column 4, lines 26-31) and the combined signal is a physical layer (i.e., analog) signal (column 4, lines 3-6).

Response to Arguments

32. Applicant's arguments filed 27 July 2006 have been fully considered but they are not persuasive.

33. On pages 11 through 12 of the response filed on 27 July 2006, applicant alleges that the recitation on page 46, lines 27-30 of the original disclosure provides support for the invention claimed in Claim 1. Examiner respectfully disagrees. Claim 1 requires an embodiment that converts one of a set of combined signals on an interface into two separate signals, each comprising digitally formatted video information in a distinct digital video format, and combines one of the separate signals with additional signal from a different interface and maps the combined signal and the signal comprising the digitally formatted video information in the digital video format that was not combined with the additional signal onto separate interfaces for distribution. The passage from the original disclosure to which applicant refers reads in full:

Processing system 1112, in certain embodiments, can comprise a processing device (for instance, a digital signal processor) operable to decode a signal encoded by a remote transmission algorithm, producing digitally-formatted video information, for instance, MPEG2 data and/or HDTV signals.

As such, this part of the disclosure is descriptive of a processor that is a component of a processing system that is included in the network interface device claimed. The recitation that

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this component is operable to perform a certain function is not sufficient to support a claim that requires that function. Further, while the conjunction and/or is used to describe the format of video information the processor produces, this is not sufficient to support a claim that the processor produce both video formats simultaneously. In addition, because applicant uses the conjunction and/or wherever possible in the disclosure (approximately 180 times), it is clear that it's use does not indicate possession of the invention encompassing all elements listed. It is simply applicant's default list ending conjunction. Finally, the remaining elements of the claim are not disclosed by applicant in a single embodiment. As such, the claim is not supported by the original disclosure and the rejection under 35 USC 112, first paragraph is maintained.

34. In the third through fifth paragraphs on page 12 of the response, applicant makes a piecemeal argument that none of the cited references teaches converting a signal into two different digital video output formats. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Rabenko teaches one digital video output format and Okawa provides teaching and motivation for adding a second output format.

35. In the first complete paragraph on page 13 of the response, applicant alleges that there is no motivation to combine the teachings of the cited references. Examiner respectfully disagrees. As shown in the prior art rejections above, the motivation is based on statements made in the references cited.

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Swerdlow whose telephone number is 571-272-7531. The examiner can normally be reached on Monday through Friday between 7:30 AM and 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh H. Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel Swerdlow
Primary Examiner
Art Unit 2615

ds
18 September 2006